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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/540,361

10/20/2005

Anja Stork

J&J5012USPCT

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03/17/2009

PHILIP S. JOHNSON

JOHNSON & JOHNSON

ONE JOHNSON & JOHNSON PLAZA

NEW BRUNSWICK, NJ 08933-7003

EXAMINER

WELTER, RACHAEL E

ART UNIT

PAPER NUMBER

1611

MAIL DATE

DELIVERY MODE

03/17/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/540,361	Applicant(s) STORK ET AL.	
	Examiner RACHAEL E. WELTER	Art Unit 1611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/23/05, 9/2/08, 12/17/08</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response To Applicant's Election

Applicant's election with traverse of the species election in the reply filed 12/1/08 is acknowledged. However, upon reconsideration, the examiner has decided to withdraw the election of species requirement.

Claim Status: Claims 1-10 are pending.

Claims 1-10 will be examined.

Information Disclosure Statement

The information disclosure statements (IDS) submitted on June 23, 2005, September 2, 2008, and December 17, 2008 were in compliance with the provisions of 37 CFR 1.97 and 37 CFR 1.98. Accordingly, the information disclosure statements were considered by the examiner. A signed copy of forms 1449 are enclosed herewith. Applicant should note that reference, US Patent No. 6,006,314 was not considered because it appears to be an incorrect number.

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 recites the limitation "one or more silicone oils" in line 4 of the claim. There is insufficient antecedent basis for this limitation in the claim because claim 5 depends on claim 1, which does not support or recite silicone oils.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-2 and 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dalle et al (US Patent No. 6,013,682).

Dalle et al teach a method of making a silicone in water emulsion and teach that the s/w emulsions produced have a wide variety of silicone volume fractions, particle sizes, and molecular weights, including novel materials having large volume fractions of the silicone and large particles containing high molecular weight silicone gums (column 1, lines 58-67; column 2, lines 1-6). The silicone wax produced is a divinyl dimethicone/dimethicone copolymer resulting from the reaction of polysiloxane and at least one organosilicon material that reacts with the polysiloxane by a chain reaction in the presence of a metal containing catalyst for said chain extension reaction (column 2, lines 15-27; examples). Dalle et al further teach that the mixture used to form the emulsion also contains at least one surfactant, which can include glycols, such as polyethylene glycol, polypropylene glycol, and diethylene glycol (column 4, lines 51-55). These surfactants can be used in an amount of 1-30 wt% based on the total weight of the composition (column 5, lines 43-46). The emulsion composition is formed by mixing the silicone reaction, water, and surfactant to form a coarse water in oil mixture (column 5, lines 56-60). Accordingly, the mixture is emulsified and inverted into a silicone in water emulsion. Dalle et al teach that the emulsifier, Laureth-3 and Laureth-23 are added to the emulsion in examples 1-5, which are used an amount of approximately 3 wt.%. According to the instant specification, preferred emulsifiers are ethoxylated lauryl alcohol (Laureth), pg. 11, lines 28-29. The emulsions according to Dalle et al can be useful for a personal care applications such as on hair, skin, mucous, teeth, etc (column 7, lines 8-27). Dalle et al teach that emulsions can be used in hair shampoos, hair conditioners, hair sprays, mousses, permanents, etc. Moreover, Dalle

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et al teach that the waxes can be incorporated in the personal care products in an amount of 0.1 to 25 wt.% of the personal care product (column 7, lines 27-30).

Although Dalle et al suggest the use of polyols, such as polyethylene/propylene glycol, in the oil-in-water emulsion they are not immediately envisaged and therefore the instant rejection is made under obviousness.

However, it would have been obvious to an artisan of ordinary skill at the time the invention was made to look at the guidance provided by Dalle et al and incorporate polyols, such as polyethylene/propylene glycol into the oil-in-water emulsion. One would have been motivated to do so since Dalle et al list polyethylene/propylene glycol as a suitable non-ionic surfactant. Furthermore, Dalle et al state that the particle size of the silicone in the emulsion is dependent on the amount and type of surfactant employed. Thus, an artisan of ordinary skill would be motivated to include polyethylene glycol/propylene glycol (non-ionic surfactant) depending on the desired particle size of the silicone.

Regarding the oil-in-water emulsion being clear, Dalle et al is silent whether the emulsion is clear or cloudy. However, it is the position of the examiner that this limitation would be an obvious expected property of the emulsion because Dalle et al suggest an emulsion with the same components as the instant application. According to MPEP 2112.02, products of identical chemical composition can not have mutually exclusive properties. A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present as *In re Spada*, 911 F.2d 705,

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709, 15 USPQ2d 1655, 1658 (*Fed. Cir.* 1990). In addition, since applicant the examiner has no access to laboratory equipment, burden is shifted to applicant to prove otherwise as *In re Fitzgerald*, 619 F.2d 67, 205 USPQ 594 (CCPA 1980). Furthermore, the examiner notes that Dalle et al teach fine particle sizes, such as 8.5 microns, 5 microns, 13 microns, 2.2 microns (see examples 4-6) that are encompassed by particle sizes in the instant specification. According to the instant specification, particle sizes of sprayable oil-like formulations are in the range from about 0.3 -10 microns (pg. 5, lines 1-6). An artisan of ordinary skill knows that such fine particle sizes result in clear emulsions. Thus, since the instant application and Dalle et al teach similar particle sizes, the examiner has no reason to believe that Dalle et al is teaching a cloudy emulsion. Moreover, since the instant method of making the emulsion is just a simple process of mixing (see example 1 in the specification) and Dalle et al teach mixing in conjunction with inversion, there is nothing in the method of making the emulsions that suggests Dalle et al is not teaching a clear emulsion.

Regarding the limitation that the oil-in-water emulsion has to be sprayable, Dalle et al clearly teach that the emulsion can be used in personal care products, such as hair sprays.

Claims 3-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dalle et al (US Patent No. 6,013,682) as applied to claims 1-2 and 9-10 above and in further view of Kasprzak (US Patent No. 5,443,760).

The disclosure of Dalle et al is discussed above.

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Dalle et al do not disclose an emulsion with an oily component further comprising suitable oils, such as silicone oils. Furthermore, Dalle et al do not teach an emulsion comprising the polyol, glycerin.

Kasprzak teaches oil-in-water emulsions comprising an oil phase with volatile and non-volatile silicone oils (column 1, lines 52-59). According to Kasprzak, these emulsions can be present in amount from 0.1-60 wt.% (column 8, lines 3-7). Like Dalle et al, the emulsion comprises propylene glycol in its aqueous phase. In addition to propylene glycol, Kasprzak also teaches that glycerin, hexylene glycol, glucose, lactic acid, etc can be used as humectants (column 5, lines 38-46).

Therefore, it would have been obvious to an artisan of ordinary skill at the time the invention was made to add silicone oils to the oily component in the emulsion of Dalle et al. One would have been motivated to do so because silicone oils are also used in oil-in-water emulsions, as suggested by Kasprzak. Furthermore, one would have been motivated to do so because the combined ingredients of silicone wax and silicone oils as the oily component of the oil-in-water emulsion would result in a complementary or possibly synergistic effect. It is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose.... [T]he idea of combining them flows logically from their having been individually taught in the prior art." *In re Kerkhoven*, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980) (see MPEP 2144.06).

Furthermore, it would have been obvious to an artisan of ordinary skill at the time

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the invention was made to combine the teachings above and utilize the polyols of Dalle et al or Kasprzak. One would have been motivated to do so since Kasprzak teach that the instant humectant and Dalle's surfactant are both humectants added to the aqueous phase of oil-in-water emulsion. Thus, one would have been motivated to substitute the instant humectant (glycerin) into the composition of Dalle et al with an expectation of similar results since Kasprzak et al teach the equivalency of the polyols.

Regarding the amounts of silicone waxes, silicone oils, and emulsifiers in the instant claims, Dalle et al teach that the emulsifiers (Laureth-3 and Laureth-23) are taught in amount of about 3 wt.%. Furthermore, Dalle et al teach that the silicone wax can be incorporated in personal care products in an amount of 0.1 to 25 wt.% of the total weight of the product. Kasprzak et al teach that the silicone oils can be present in an amount from 0.1-60 wt.%. Thus, the amount of the silicone wax, silicone oil, and emulsifer encompass and almost touch (in the case of the emulsifier) the instantly claimed amounts. However, it would have been obvious to an artisan of ordinary skill at the time the invention was made to modify and optimize the amounts of the ingredients taught in the oil-in-water emulsion. Optimization of parameters is a routine practice that would be obvious to a person of ordinary skill in the art to employ and reasonably expect success. One would have been motivated to determine the optimal amount of each ingredient in order to best achieve the desired results, which ultimately depends on the desired use of the emulsion. See *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955) & MPEP 2144.05.

Conclusion

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Claims 1-10 are rejected. No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RACHAEL E. WELTER whose telephone number is (571) 270-5237. The examiner can normally be reached 7:30-5:00 Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila Landau can be reached at 571-272-0614. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

REW

/Lakshmi S Channavajjala/

Primary Examiner, Art Unit 1611

March 13, 2009